

a database in the specification is not sufficient to enable Claims 23, 25, and 26. The Examiner believes that while the claims are enabled at the present time by the submission to the Protein Data Bank, there is no guarantee that the information will be available in the future.

It is submitted that the Examiner's requirement that the claims must be enabled in the future is not well taken. To summarize, the Examiner's position is that the submission to the Protein Data Bank provides enablement for Claims 23, 25, and 26 for today (i.e., the present), but possibly not for tomorrow (i.e., the future) because the Protein Data Bank may not exist in the future, thereby removing access to the submitted information. The Examiner has loosely based her position on the requirements for the submission and deposit of biological materials.

It is submitted that the regulations referred to by the Examiner are directed towards the deposit of biological materials and not to the support and maintenance of a database entry. Therefore, it is submitted that this rejection is not proper. Additionally, it is submitted that the Examiner's analogy is flawed. Applicants have been unable to locate any support for the Examiner's position in the patent statutes, the PTO Rules, or, for that matter, in the MPEP. Therefore, the rejection lacks statutory or regulatory support because there is no requirement that the Applicants demonstrate that the Protein Data Bank will exist in the future. Furthermore, Applicants have satisfied the regulatory and statutory requirements because the claims are presently enabled by the disclosure to the Protein Data Bank.

Additionally, it is submitted that the Examiner's very own analogy renders her conclusion (the rejection) improper because section 2404.01 of the MPEP states that the deposit of a biological material does not require the Applicant to guarantee that the material will be available forever. Section 2404.01 states that:

By showing that the biological material is known and readily available or by making a deposit in accordance with these rules, applicant does not guarantee that such biological material will be available forever. ... Although there is a public interest in the availability of a deposited biological material during and after the period of enforceability of a patent, there should not be any undue concern about continued access to the public. See 37 CFR 1.806 (the term of deposit is "at least thirty (30) years and at least five (5) years after the most recent request" for a sample; the agreement sufficiently ensures that the deposit will be "available beyond the enforceable life of the patent"). Unless there is reasonable basis to believe that the biological material will cease to be available during the enforceable life of the patent, current availability would satisfy the requirement. The incentives provided by the patent system should not be constrained by the mere possibility that a disclosure that was once enabling would become non-enabling over a period of time through no fault of the patentee. (emphasis added)

Because the Protein Data Bank is managed by reputable organizations and universities, it is submitted that there is no reasonable basis upon which to believe that the material submitted to the Protein Data Bank would cease to exist before the expiration of any patent that would issue on the above referenced application. Therefore, the Examiner's requirement is flawed based upon the very analogy drawn in the Office Action.

Also attached to this Response is a copy of the complete submission (in computer readable form) made to the Protein Data Bank. This submission is made to supplement to the arguments presented above. It is submitted that the provision of a copy of the complete (and previously made) submission to the Data Bank overcomes the enablement rejection because the patent file will become public record upon allowance of the application and, therefore, the submission will be available to the public upon issuance of the patent.

The Examiner has also requested that a sequence listing be provided in the present case. Applicants are in the process of obtaining the requested sequence information and will provide it to the Examiner shortly in the form of a Supplemental Response. It is requested that the Examiner place this rejection in abeyance until she receives said Supplemental Response.

Additionally, the Examiner requested that corrected drawings be submitted with this Response. Applicants are in the process of obtaining the corrected drawings and will provide them to the Examiner for approval shortly. Said corrected drawings will also be provided in the form of a Supplemental Response. It is requested that the Examiner also place this rejection in abeyance until she receives said Supplemental Response.

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 01-2300, referring to client-matter number 100564-09039.

Should the Examiner deem that any further action by the Applicants would be desirable for placing this application in even better condition for issue, the Examiner is requested to telephone applicants' undersigned representative at the number listed below.

Respectfully submitted,



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Enclosure: Protein Data Bank Submission (Computer Readable Form)